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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,079	12/11/2000	Gunnar Andersson	215547.01301	1940

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EXAMINER

PATTERSON, MARC A

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/733,079

Applicant(s)

ANDERSSON ET AL. 

Examiner

Marc A Patterson

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 14 January 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-34.Claim(s) withdrawn from consideration: none.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See attached.

ADVISORY ACTION***Acknowledgement of Applicant's Amendments***

1. The amendment made in Claim 1 in the After Final Amendment filed January 13, 2004 has not been entered because the amendment raises a new issue. The claims prior to amendment were not directed to a 'yield point.' The amendment would therefore require further search and consideration to be completely addressed. Furthermore, as stated on page 2 of the previous Action, the process which constitutes the DIN EN ISO 527-1 to -3 1996 standard has not been defined in the claim and the 'yield' is therefore assumed to be any yield which is inherent to the film disclosed by Heilmann et al.

ANSWERS TO APPLICANT'S ARGUMENTS

2. Applicant's arguments regarding the 35 U.S.C. 102(b) rejection of Claims 1 - 7, 14 and 20 - 33 as being anticipated by Heilmann et al (U.S. Patent No. 5,783,269), 35 U.S.C. 103(a) rejection of Claims 8 - 9 and 18 - 19 as being unpatentable over Heilmann et al. (U.S. Patent No. 5,783,269), 35 U.S.C. 103(a) rejection of Claims 20 - 22 as being unpatentable over Heilmann et al (U.S. Patent No. 5,783,269), 35 U.S.C. 103(a) rejection of Claims 10 - 13 and 15 - 17 as being unpatentable over Heilmann et al (U.S. Patent No. 5,783,269) in view of Laurin et al (U.S. Patent No. 5,686,527) and 35 U.S.C. 103(a) of Claim 34 as being unpatentable over Heilmann et al (U.S. Patent No. 5,783,269) in view of Barney et al (U.S Patent No. 6,348,568), of record on page 2 of the previous Action, have been carefully considered but have not been found to be persuasive for the reasons set forth below.

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Applicant argues, on page 17 of Paper No. 14, that the rejection is improper because one of ordinary skill in the art would not have been motivated to provide for the modulus of Laurin et al in Heilmann et al. However, as stated on page 6 of the previous Action, Laurin et al teach a modulus of elasticity for a sterilizable film, ranging from 22 – 45 kilopounds per square inch (150 – 300 MPa; column 10, lines 1 – 30) for the purpose of making a film which is easy to manufacture into useful articles (column 1, lines 45 – 54). The desirability of providing for a modulus of elasticity ranging from 22 – 45 kilopounds per square inch in Heilmann et al, which is a sterilizable film, would therefore have been obvious to one of ordinary skill in the art.

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for a modulus of elasticity for a sterilizable film, ranging from 22 – 45 kilopounds per square inch in Heilmann et al in order to make a film which is easy to manufacture into useful articles as taught by Laurin et al.

Laurin et al fail to disclose a modulus of elasticity of greater than 400 MPa. However, Laurin et al. disclose a modulus of elasticity of 150 – 300 MPa. Therefore, the modulus of elasticity would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end use of the product. It therefore would be obvious for one of ordinary skill in the art to vary the modulus of elasticity, since the modulus of elasticity would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result as shown by Laurin et al. *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980).

Applicant also argues on page 17 that one of ordinary skill in the art would not have been motivated to provide for the containment of fluid lipophilic emulsions of Barney et al in

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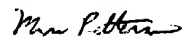
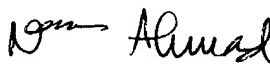
Heilmann et al. However, as stated on page 6 of the previous Action, Barney et al teaches that parenteral fluids and lipophilic emulsions are equivalent as aqueous solutions (column 58, lines 63 – 67; column 59, lines 1 – 10) for the purpose of preparing an oily injection mixture (column 58, lines 63 – 67). The desirability of providing for fluid lipophilic emulsions in Heilmann et al, which is packaging for parenteral fluids, would therefore be obvious to one of ordinary skill in the art.

It therefore would have been obvious for one of ordinary skill in the art at the time Applicant's invention was made to have provided for storage of lipophilic emulsions in Heilmann et al in order to prepare an oily injection mixture as taught by Barney et al.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (571) 272 – 1497. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (571) 272 – 1498. FAX communications should be sent to (703) 872-9310. FAXs received after 4 P.M. will not be processed until the following business day.

Marc A. Patterson, PhD.


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NASSER AHMAD
PRIMARY EXAMINER